

In the Drawings

Please enter the attached replacement sheet of drawings. Applicant has included the legend "Prior Art" in Fig. 2.

Remarks

The application has been reviewed in light of the Official Action mailed February 3, 2006. Claims 12 and 15 are amended. Claims 1-11 are cancelled. Claims 18-21 are new. Claims 12-21 are pending in the application.

No new matter is introduced by the amendments. The amendments correspond to the Examiner's objection and matter previously presented in the claims.

The Examiner objected to Fig. 2. Applicant submits a replacement sheet of drawings with Fig. 2 including the legend "Prior Art."

The Examiner objected to claim 12 for the term "stat." Applicant has amended claim 12 to include the term "state."

The Examiner rejected claims 12, 14, 15 and 17 under 102(e) as being anticipated by Ellman (US 6652514). Ellman was filed on September 13, 2001 and does not claim an earlier priority. This Application claims priority to German Application No. 101 28 377.6 filed on June 8, 2001. To perfect this claim of priority Applicant submits herewith a certified copy of the priority document. Based on the foregoing, Applicant respectfully submits that Ellman does not anticipate the claimed invention under 35 U.S.C. 102(e).

The Examiner rejected claims 12-14 under 35 U.S.C. 102(b) as being anticipated by Newton (US 4,827,927). Applicant respectfully requests that the Examiner reconsider the rejection in light of the fact that amended Claim 12 requires a control signal line and "a first signal coder assigned to said first switch, a second signal coder assigned to said second switch, wherein said first signal coder and said second signal coder are also assigned to said at least one third switch."

Newton teaches an electrosurgical apparatus, with at least three switches 28, 30, 34, an active line 22, a coagulation line 24 and a cut line 26. These three lines are fed into decoding circuitry 51 which, along with transformer 98 and microprocessor 96, is included in generator 10. (col. 4 l. 11-15). Switch 28 or 30 route current from active line 22 to coagulation line 24 or cut line 26 respectively. Switch 34 routes current from active line 22 to both coagulation line 24 and cut line 26. Figure 3 shows a series of resistors that are incorporated in the voltage dividers 70, 71, 77. It should be noted that the present application identifies the equivalent of Newton, EP 0186 369 A1, and notes that EP '369 requires three signal lines overall for the four switches to be connected to the HF generator.

The Examiner states that Newton discloses first, second, and third switches, and that each switch operates to code a particular mode. Nonetheless, Applicant submits that Newton does not anticipate the amended claims 12-14. The apparatus in Newton does not assign a first signal coder to the first switch, a second signal coder to the second switch, and both signal coders to the third switch. This apparatus merely routes the current from the active line 22 to the decoding circuitry 51. Further, the apparatus in Newton requires three signal lines overall for the switches to be connected to the HF generator. Claims 12-14 on the otherhand require the first, second and at least one third switches to be connected to an HF generator via a control signal line. Still further, claims 12-14 are not anticipated by switches that "code a particular mode." Claims 12-14 require first, second, and third switches, and a first coder and a second coder. Newton only discloses switches. As a result, Newton does not anticipate amended claims 12-14.

The Examiner rejected claims 15-17 under 35 U.S.C. 102(b) as being anticipated by Newton (US 4,827,927). Applicant respectfully requests that the Examiner reconsider the rejection in light of the fact that amended Claim 15 requires a control signal

line and "a first signal coder assigned to said first switch, a second signal coder assigned to said second switch, a third signal coder assigned to said at least one third switch is differing from said first and second signal coder."

The Examiner also stated that Newton anticipated claims 15-17 because it discloses first, second, and third switches, and that each switch operates to code a particular mode. Applicant respectfully submits that Newton does not anticipate amended claims 15-17. The apparatus in Newton does not assign a first signal coder to the first switch, a second signal coder to the second switch, and a third signal coder to the third switch. As noted above, the apparatus in Newton requires three signal lines overall for the switches to be connected to the HF generator. Claims 15-17 on the other hand require the first, second and at least one third switches to be connected to an HF generator via a control signal line. Still further, claims 12-14 are not anticipated by switches that "code a particular mode." Claims 12-14 require first, second, and third switches, and a first, second, and third coders. Newton only discloses switches. As a result, Newton does not anticipate amended claims 15-17.

The Examiner rejected claims 12 and 14 under 102(b) as being anticipated by German Publication 2,429,021 ("DE '021"). Applicant respectfully requests that the Examiner reconsider the rejection in light of the fact that amended Claim 12 requires a control signal line and "a first signal coder assigned to said first switch, a second signal coder assigned to said second switch, wherein said first signal coder and said second signal coder are also assigned to said at least one third switch."

DE '021 discloses an electrosurgical apparatus, which comprises three switches 19-21. A first signal coder 23 is assigned to first switch 20, a second signal coder 24 is assigned to second switch 21, and a signal coder is not assigned to third switch 19.

Closing third switch 19 simply produces a short between the main line 16 and the signal line 17.

The Examiner states that DE '021 anticipates the claims 12 and 14 because the "switches are 'coded' using diodes 23, 24 and the switches are connected in parallel." Nonetheless, Applicant respectfully submits that DE '021 does not anticipate amended claims 12-14. The apparatus in DE '021 does not assign a first signal coder to the first switch, a second signal coder to the second switch, and both signal coders to the third switch. The Examiner notes that switch 19 provides a direct line. Thus, DE '021 does not assign a signal coder to the first, second and third switches. Further, claims 12-14 are not anticipated by "switches that are 'code'." Claims 12-14 require first, second, and third switches; a first coder and a second coder; and three switches to be associated with at least one coder. DE '021 only discloses 2 switches that are associated with a corresponding coder, and a third switch that is not associated with any coder. As a result, DE '021 does not anticipate claims 12-14 because it does not disclose all elements of these claims.

The Examiner rejected claims 15 and 17 under 102(b) as being anticipated by German Publication 2,429,021 ("DE '021"). Applicant respectfully requests that the Examiner reconsider the rejection in light of the fact that amended Claim 15 requires a control signal line and "a first signal coder assigned to said first switch, a second signal coder assigned to said second switch, a third signal coder assigned to said at least one third switch is differing from said first and second signal coder."

The Examiner applies the same basis for rejecting claims 15 and 17 as claims 12 and 14. For substantially the same reasons stated above, Applicant submits that DE '021 does not anticipate amended claims 15-17. As noted above, the Examiner notes that switch 19 provides a direct line. Thus, DE '021 does not assign signal coders to

corresponding first, second and third switches. Further, claims 15-17 are not anticipated by "switches that are 'coded'." Claims 15-17 require first, second, and third switches, and first, second, and third coders. DE '021 only discloses 2 switches that are associated with corresponding coders, and a third switch that is not associated with any coder. As a result, DE '021 does not anticipate claims 15-17 because it does not disclose all elements of these claims.

For both Newton and DE '021 the Examiner suggests that because both apparatuses provide a signal that is "coded" then these references anticipate claims directed to first, second, and third switches with at least one coder associated with each switch. However, Applicant believes that the Examiner does not recognize the functional difference between Newton, DE '021 and the claimed invention. Newton and DE '021 both disclose apparatuses that provide direct lines between the active or main lines and the HF Generator's. Switches that provide direct lines lack the ability to limit the current that is routed to an HF Generator. As a result, for an HF Generator to interact with such an apparatus, a resistor must be incorporated in the HF Generator to avoid an operational breakdown of the HF generator. This is exhibited in Figure 2 of DE '021 and Fig. 3 of Newton. If a new HF instrument is introduced into the market, they are often used with already existing older HF Generators. Figure 2 of this Application shows a prior HF instrument that has two switches with corresponding coders. An HF Generator that is designed to accompany such an HF instrument would not be designed to incorporate a resistor that would limit the flow of current already achieved by the pair of coders. Applying the HF instruments of DE '021, with one direct switch, or Newton with three direct switches, would require an HF Generator corresponding to the device in Figure 2 to be retrofitted with a resistor in order to avoid short-circuiting the HF Generator. An apparatus with three switches and at least one coder assigned to each switch has the advantage of being able to be incorporated with older HF Generators of different designs without requiring the HF Generators to be modified. This is a capabil-

ity that cannot be achieved by the HF Instruments in Newton or DE '021. As a result, these references do not anticipate the claimed invention.

Further, Applicants respectfully submit that there is no motivation to modify or combine the references in accordance with the claimed invention. It is well settled that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). As discussed above it is questionable whether one skilled in the art would be motivated to combine these references. Each HF Generator disclosed in these references is designed to correspond to the particular characteristics of the HF Instruments. This is especially due to the fact that both references have at least the third switch provide a direct line between the active line and the HF Generator. Swapping an HF Instrument of one design with another could lead to failure of the HF Generator. As a result, it is likely that one skilled in the art would be reluctant to combine teachings of different HF Instruments.

Still further, neither reference fairly suggests the claimed invention in claims 12 and 15. As noted by the Examiner, switch 19 of DE '021 provides a short between the main line and the HF Generator. Newton discloses three switches which all provide a direct connection between active line 22 and decoding circuitry 51. Based on the foregoing, all references disclose that at least the third switch provides a direct line between the active line and the HF Generator. As a result, one skilled in the art would not be motivated to modify either reference to include "a first signal coder assigned to said first switch, a second signal coder assigned to said second switch, wherein said first signal coder and said second signal coder are also assigned to said at least one third switch," or "a first signal coder assigned to said first switch, a second signal coder assigned to said second switch, a third signal coder assigned to said at least one third switch is differing from said first and second signal coder."

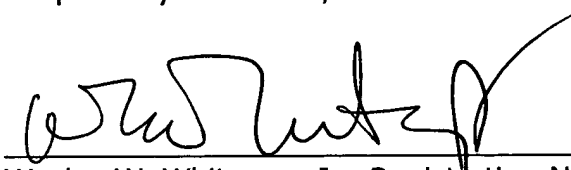
Also, since neither reference discloses a first, second, and third switch with at least one corresponding coder, any combination of these references would still lack such an embodiment. Applying DE '021 to Newton would result in an HF instrument with first and second switches with corresponding coders and a third switch that applied the full current from the active line to the decoding circuitry 51. Applying Newton to DE '021 would result in an HF instrument with first, second, and third switches without any corresponding coders between the mainline and the HF Generator. Despite the combination of these references it is still unknown if such combinations could even function. Nevertheless the combination of these references would not yield "a first signal coder assigned to said first switch, a second signal coder assigned to said second switch, wherein said first signal coder and said second signal coder are also assigned to said at least one third switch," or "a first signal coder assigned to said first switch, a second signal coder assigned to said second switch, a third signal coder assigned to said at least one third switch is differing from said first and second signal coder."

Based on the foregoing, Applicant respectfully submits that neither reference on its own or in combination with each other renders the claimed invention requiring "a first signal coder assigned to said first switch, a second signal coder assigned to said second switch, wherein said first signal coder and said second signal coder are also assigned to said at least one third switch," or "a first signal coder assigned to said first switch, a second signal coder assigned to said second switch, a third signal coder assigned to said at least one third switch is differing from said first and second signal coder," obvious.

In view of the foregoing amendments and remarks, it is respectfully submitted that all of the claims currently pending in the application are now in condition for allowance. Reconsideration and notice to that effect is earnestly requested.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read 'Wesley W. Whitmyer, Jr.', written over a horizontal line.

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